



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/131,744	08/10/98	KOITABASHI	N 884.2742

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FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK NY 10112

EXAMINER

GRENDZYNSKI, M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED:

08/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/131,744

Applicant(s)

Koltabashi et al.

Examiner

Grendzynski, Michael E.

Group Art Unit

1774



☒ Responsive to communication(s) filed on Aug 10, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-9 is/are pending in the application

Of the above, claim(s) 8 and 9/2 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 and 9/1 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6 & 8

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I (claims 1-7 and 9/1) in Paper No. 10 is acknowledged. The traversal is on the ground(s) that examination of Group II would not pose an undue burden on the examiner. This is not found persuasive because, as indicated in the Action of May, 200, the claimed subject matter requires a different mode of operation caused by different material effects. The requirement is still deemed proper and is therefore made FINAL.

Upon further consideration, however, the election of species requirement is *withdrawn*.

Claim 8 and 9/8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

This application contains claim 8 and 9/8 drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Presently, the composition of the processing liquid is unclear. Processing liquid may be chromatic or achromatic--which is the processing liquid of the present invention? The specification appears to enable only an achromatic processing liquid. Clarification is respectfully requested.

With specific regard to claim 7, the method steps are unclear. Are applicants intending to claim the method of claim 1 or 5 further comprising the step of ejecting a second ink? What do applicants intend by color ink? Any ink that is not black ink?

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shioya or Yokoi. Applicants claim a method of recording comprising ejecting ink having a K_a value of not more than $3 \text{ mlm} / \text{m}^2 \text{sec}^{-1/2}$ onto a recording material, and then ejecting a processing liquid having a K_a value of not less than $5 \text{ mlm} / \text{m}^2 \text{sec}^{-1/2}$ onto the ink. Shioya discloses a process whereby ink is ejected onto a recording medium, and then a processing liquid is ejected onto the ink. The claimed K_a values are not dispositive on the issue of

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patentability. It is the examiner's position that all ink possesses a diffusion value (i.e., a Ka value). The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. Diffusion value of an ink is a common concern in the art to control the speed at which an ink spreads in a medium (thus controlling bleeding properties). Consequently, it would be obvious to optimize.

Yokoi discloses a method whereby ink is discharged onto a recording medium and then a processing liquid is discharged onto the ink. *See* col. 3, lines 45-50. Again, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. Diffusion value of an ink is a common concern in the art to control the speed at which an ink spreads in a medium (thus controlling bleeding properties). Consequently, it would be obvious to optimize.

7. Claims 1-7 and 9/1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shioya or Yokoi, as applied to claim 1, above, in further view of Inui. Inui teaches that it is known in the art to heat liquid ink to accelerate its drying and to prevent bleeding. *See* col. 2, lines 27-30. It would have been obvious to one of ordinary skill in the art at the time of the invention to heat the ink and processing liquid of either Shioya or Yokoi, motivated by the desire of accelerating the drying of the liquids, thus preventing their bleeding, as is known in the art, taught by Inui on col. 2, lines 27-30.

Conclusion

8. Should you have any questions concerning this communication, please direct them to Michael E. Grendzynski at telephone number (703) 305-0593. The examiner can be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the

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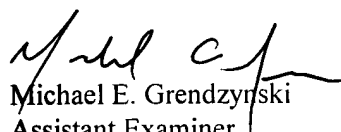
examiner's supervisor, William Krynski, can be reached at (703) 308-2376. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes, and (703)305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.



**BRUCE H. HESS
PRIMARY EXAMINER
GROUP 1300**



Michael E. Grendzynski
Assistant Examiner
August 10, 2000